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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/783,346

02/20/2004

Maura Jane Stafford

P-92835-18K(UT)

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7590

06/01/2005

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EXAMINER

WRIGHT, DIRK

ART UNIT

PAPER NUMBER

3681

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|----------------------------------------|--|
| Office Action Summary | Application No. 10/783,346 | Applicant(s) STAFFORD ET AL. | |
| | Examiner Dirk Wright | Art Unit 3681 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 is/are allowed.
- 6) ☒ Claim(s) 10-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>02202004</u> . | 6) <input type="checkbox"/> Other: ____ |

Claims Rejected

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. In claim 10, the term "oversize" is confusing because it is not clear as to which aspect of the first and second valve disc, as well as the end plug, is "oversize". There is also no frame of reference for the term; oversize relative to what? Finally, it is not clear how a valve disc could be oversize and yet remain slidable, since presumably an oversize valve would require a press fit, and thus not be slidable. The term doesn't really have any meaning within the context of the claim.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 10, as best understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Maddalozzo '709 and Dudash '407. Claim 10 is not limited to valves in automatic transmissions. Maddalozzo shows a plug 33 with a groove and O-ring, as well as a first valve disc 18 with stem portion 35, and second valve disc 27. Dudash shows a plug 220 with O-ring 225 a second valve disc 205 on stem portion 190 of first valve disc 60. Either of these valves could be used in the valve body of an automatic transmission.

The examiner takes Official Notice that any claimed subject matter that is not specifically addressed in the rejection of the claims is old and well known to those of ordinary skill in this art. See MPEP 2144.03

Claims Allowed

Claims 1-9 are allowable over the prior art of record. The claims are allowable because the prior art does not anticipate nor render obvious the claimed combination of: an improved solenoid switch valve assembly for use in combination with a valve body of an automatic transmission, said solenoid switch valve assembly regulating the flow of automatic transmission fluid to a low/reverse apply circuit in a first position thereof and, alternatively, to a lock-up apply circuit in a second position thereof, said solenoid switch valve assembly including a solenoid switch valve and a pair of valve discs arranged in end-to-end relation for reciprocating movement within said valve body in fluid communication with said circuits, wherein the improvement comprises: a tandem disc set wherein a mating pair of oversize valve discs are interlocked in sliding engagement to permit axial shifting movement of said discs relative to one another and reciprocating movement of said discs as a unit within said valve bore; or: a method of improving hydraulic control of a torque converter within a automatic transmission system, wherein said transmission system includes an original equipment solenoid switch valve assembly within a valve body thereof for regulating the flow of automatic transmission fluid to a low/reverse apply circuit and, alternatively, to a lock-up apply circuit within said system, said solenoid switch valve assembly including a solenoid switch valve member and a pair of switch valve discs arranged in end-to-end relation for reciprocating movement within a valve bore in said valve body in fluid communication with said circuits, said method comprising the steps of:

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removing said original equipment solenoid switch valve assembly from said valve bore; inspecting said valve bore for excessive wear; providing a replacement solenoid switch valve assembly including a tandem disc set having interlocking valve discs imparted with axial shifting movement relative to each other; and installing said replacement solenoid switch valve assembly including said tandem disc set into said valve bore..

No particular single feature of the claim renders the claim as a whole patentable. Only the claim taken as a whole combination is deemed new and unobvious.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Prior Art Discussed

The examiner has considered the references cited by applicant in his Information Disclosure Statement filed concurrently with the application. The reference does not show all of the features of the claimed combination.

The references cited by the examiner are deemed pertinent to applicant's disclosure. None of the references show all of the features of the claimed combination.

Conclusion

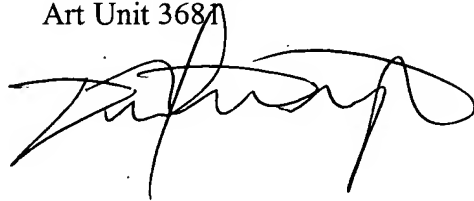
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dirk Wright whose telephone number is 571-272-7098. The examiner can normally be reached on Monday through Friday, 8AM-4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dirk Wright
Primary Examiner
Art Unit 3681

A handwritten signature in black ink, appearing to read 'Dirk Wright', with a stylized, flowing script.

DW
Monday, May 23, 2005